



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/844,954

04/26/2001

Randolph M. Linenberger

40203.2USU1

1318

7590

05/03/2004

Thomas H. Thomas
Merchant & Gould, P.C.
3200 IDS Center
80 South Eight Street
Minneapolis, MN 55402

EXAMINER

FLORES SANCHEZ, OMAR

ART UNIT

PAPER NUMBER

3724

17

DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/844,954

Applicant(s)

LINENBERGER, RANDOLPH M.

Examiner

Omar Flores-Sánchez

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 30 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 4-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to applicant's amendment received on 1/04/2004.

Information Disclosure Statement

2. The information disclosure statement filed 2/06/04 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Specification

3. The amendment filed 1/04/2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "*compound levers*" located in claim 9 and Fig. 3 and 7 (i.e., in figure 3 the dimpler are missing).

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3724

5. Claims 15-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15, it is not clear if it depends from claim 11 or 12.

Claim 16, the preamble *the apparatus* needs to be changed to *the method*.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4-7 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berry in view of Irvello.

Berry discloses the invention substantially as claimed including notchers (78, 80 and 82) having different angle widths and at least one shear 16. Berry doesn't show at least one dimpler. However, Irvello teaches the use of a dimpler (Fig. 7) for the purpose of making dimples on a strip to be bent. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Berry's device by providing the dimpler as taught by Irvello in order to facilitate the bending of the strip. Also, the modified device of Berry is capable of performing the function set for in the preamble.

Art Unit: 3724

8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berry in view of Irvello as applied to claims 4, 6 and 7 above.

The modified device of Berry discloses the invention substantially as claimed except for an angle of approximately 80 and 120 degrees. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Berry's notchers by providing the angle of approximately 80 and 120 degrees for the purpose of bending the workpiece to the desired position, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

9. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berry in view of Irvello as applied to claim 4 above.

The modified device of Berry discloses the invention substantially as claimed including feeding means 12. Berry does not show a stepper motor. However, the examiner takes Official Notice that the use of a stepper motor is old and well known in the art for the purpose of accurately moving the workpiece at predetermined time intervals. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Berry's feeding means by providing the stepper motor in order to accurately move the workpiece at predetermined time intervals to the notching machine.

Art Unit: 3724

10. Claims 12-15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berry in view of Irvello.

Berry discloses the method for preparing trim cap material substantially as claimed including the step of notching said trim cap material using notchers Fig.1. Berry doesn't show the step of dimpling said trim cap material using at least one dimpler. However, Irvello teaches the step of dimpling said trim cap material using at least one dimpler (Fig. 4-5) for the purpose of making dimples on a strip to be bent. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Berry's device by providing the step of dimpling said trim cap material using at least one dimpler as taught by Irvello in order to facilitate the bending of the strip. Also, Berry in view of Irvello are capable of performing the function set for in the preamble.

11. As best understood, claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berry in view of Irvello as applied to claims 12 and 15 above.

The modified device of Berry discloses the method for preparing trim cap material substantially as claimed except for an angle of approximately 80 and 120 degrees. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Berry's notchers by providing the angle of approximately 80 and 120 degrees for the purpose of bending the workpiece to the desire position, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Response to Arguments

12. Applicant's arguments have been fully considered but they are not persuasive. In response to applicant's argument that the prior art is not relate to the formation of three-dimensional signs, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 3724

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Omar Flores-Sánchez whose telephone number is 703-308-0167. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 703-308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ofs
April 30, 2004



KENNETH E. PETERSON
PRIMARY EXAMINER